



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,617	01/30/2001	Jeffrey H. Banning	D/A0309I3I2D	8348

7590 03/28/2005

Patent Documentation Center
Xerox Corporation
Xerox Square 20th Floor
100 Clinton Ave. S.
Rochester, NY 14644

EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,617

Applicant(s)

BANNING ET AL.

Examiner

Rebecca L. Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,7 and 68-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1,2,6,7 and 68-73 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 2, 6, 7 and 68-73 are currently pending in the instant application.

Claims 1, 2, 6, 7 and 68-73 are objected.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 October 2004 has been entered.

Election/Restrictions

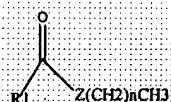
In the reply filed 19 February 2003 applicant elected a specific compound in response to a restriction requirement which resulted in the elected invention for search and examination as stated on page 3 of the action mailed 14 May 2003. Applicant argued in the response filed 14 August 2003 that the MPEP does not provide for requiring an Applicant to amend a generic claim to encompass only an elected species and that a complete examination of the generic claim of the instant application (claim 1) is required. This argument was not found persuasive since the subject matter of the pending claims other than that of the elected invention for search and examination stands withdrawn under 37 CFR 1.142(b) as being for non-elected subject matter and it is pointed out that the restriction requirement is made under 35 USC 121. 35 USC 121 gives the Commissioner (Director) the authority to limit the examination of an application

Art Unit: 1626

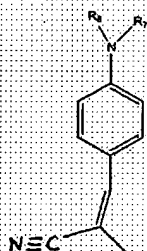
where two or more independent and distinct inventions are claimed to only one invention. The examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) claimed subject matter accordingly. Thus the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. In the response filed 22 October 2004 applicant does not provide any arguments to the contrary of the restriction requirement. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter. Accordingly, restriction as has been presented in this application is proper an FINAL. Therefore, the elected invention for search and examination is that as found in the office action mailed 14 May 2004 and repeated below:

The elected invention for search and examination is:

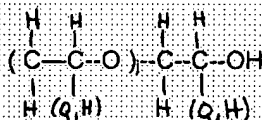
A compound having the formula:



wherein Z is -NH-; n is 17 or 39; R1 is



wherein the phenyl group may be substituted with substituents R50, R51, R52, and R53, as in claim 6, or the phenyl group may be unsubstituted as in claim 7; and R7 and R8 are hydrogen, alkyl, aryl, or



wherein j is as defined.

Claim Objections

Claims 1, 2, 6, 7, and 68-73 are objected to as containing non-elected subject matter, specifically, wherein n is other than 17 or 39. Claims 1, 2, 6, 7, and 68-73 presented drawn solely to the elected invention for search and examination identified supra would appear allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

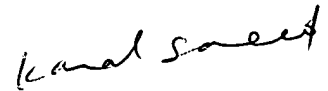
Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rebecca Anderson
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600
3/15/05

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600